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28549	7590 07/28/2005		EXAMINER	
KEVIN G. MIERZWA			LY, ANH	
ARTZ & ARTZ, P.C. 28333 TELEGRAPH ROAD, SUITE 250			ART UNIT	PAPER NUMBER
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DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
Office Action Summary	09/552,131	MELKOTE ET AL.				
Office Action Summary	Examiner	Art Unit				
The MAILING DATE of this communication	Anh Ly	2162				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1) Responsive to communication(s) filed on 04 Ma	av 2005.					
	<u> </u>					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4) Claim(s) 1-41 is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
	6)⊠ Claim(s) <u>1-41</u> is/are rejected.					
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or election requirement.						
Application Papers						
9) The specification is objected to by the Examiner.						
10)⊠ The drawing(s) filed on 19 April 2000 is/are: a)⊠ accepted or b)□ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119	•					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of: 1.☐ Certified copies of the priority documents have been received.						
 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
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Attrohmont(s)						
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Interview Commence	(DTO 412)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary (PTO-413) Paper No(s)/Mail Date					
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal P	atent Application (PTO-152)				
S. Patent and Trademark Office	5) L. Outer	•				

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DETAILED ACTION

1. This Office Action is response to Applicants' response filed on 05/04/2005.

2. Claims 1-41 are pending in this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 37 is rejected under 35 U.S.C. 101 because this claim is a non-statutory since the steps of claimed invention are able to perform manually without the use of computer system/machine. Also, especially, in the line 7 of claim 37, the database is just a software not a physical storage.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since in the line 6 of the claim, "said disclosure" is not clearly in the claimed invention.

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Claim Rejections - 35 USC § 103

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
- 8. Claims 1-3, 7, 9, 17-18, 19-20, 21-23, 24, 36, 37-38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager) in view of Pub. No.: US 2004/0230566 A1 of Balijepalli et al. (hereinafter (Balijepalli).

With respect to claim 1, Hager teaches forming an invention disclosure online by entering a plurality of selected information portions into a web-based system (an invention disclosure document is displayed as shown in fig. 4A in order to a

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user/inventor to create an invention disclosure document on-line via the network of LAN (fig. 1, Local Area Network (LAN) and col. 3, lines 40-67 and col. 4, lines 1-15) by entering inventors' information, title of invention: col. 3, lines 30-52 and col. 6, lines 41-67);

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (the entered information or information portions of invention disclosure documented is storage in the storage device: fig. 1, item 14 col. 3, lines 16-30); and

allowing access to various users for reviewing the information (the user/staff, inventor or co-inventor, who are enabled to get into the system to review the invention disclosure document: fig. 2, col. 30-45).

Hager teaches a creating an invention disclosure document by entering the information of invention into a form displayed as shown in fig. 4 via computer network such as LAN or Internet network (col. 3, lines 40-67) and the entered information or invention disclosure document is enabled for a user to review it. Also Hager teaches LAN coupled via communications link to gateway server (col. 3, lines 35-67) and a central computer system may coupled to a storage device which may serve as remote storage for LAN (col. 3, lines 30-35). Hager does not clearly teach a central storage location and web-based system.

However, Balijepalli teaches central server is coupled with database (figs. 1, 2 & 8, over the Internet network/web server: abstract, sections 0008-0010, 0030 and 0063-0064).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager with the teachings of Balijepalli, wherein the online creation of invention disclosure document to be entered via a computer network coupling to LAN communication links and storage devices in the system provided therein (Hager's figs. 1, 2 and 4), would incorporate the use of webbased system having a central storage location, in the same conventional manner as described by Balijepalli (figs. 1, 2 & 8 and section 0063-0064). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claim 2, Hager teaches step of forming includes providing identification information; whereby upon providing identification information to said web-based server; and retrieving user information from the directory system in response to the identification information (inventor's name, location: fig. 4 and col. 6, lines 41-67).

With respect to claim 3, Hager teaches step of prompting the user for classification information (functional code: col. 7, lines 1-8).

With respect to claim 7, Hager teaches ranking the disclosure (col. 7, lines 55-65; also col. 1, lines 55-65).

With respect to claim 9, Hager teaches prompting a patentability review from the patent staff person (the user/staff, inventor or co-inventor, who are enabled to get into the system to review the invention disclosure document: fig. 2, col. 30-45).

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Claim 17 is essentially the same as claim 1 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 18 is essentially the same as claim 2 except that it is directed to a system rather than a method (user ID and password: col. 18, lines 35-61), and is rejected for the same reason as applied to the claim 2 hereinabove.

With respect to claims 19-22, Hager teaches an invention disclosure system as discussed in claim 17.

Hager teaches a creating an invention disclosure document by entering the information of invention into a form displayed as shown in fig. 4 via computer network such as LAN or Internet network (col. 3, lines 40-67) and the entered information or invention disclosure document is enabled for a user to review it. Also Hager teaches LAN coupled via communications link to gateway server (col. 3, lines 35-67) and a central computer system may coupled to a storage device which may serve as remote storage for LAN (col. 3, lines 30-35). Hager does not clearly teach a web server, a web browser, web login.

However, Balijepalli teaches central server is coupled with database (figs. 1, 2 & 8, over the Internet network/web server: abstract, sections 0008-0010, 0030 and 0063-0064) and login web ser screen (figs. 5 and 6, sections 0026).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager with the teachings of Balijepalli, wherein the online creation of invention disclosure document to be entered

via a computer network coupling to LAN communication links and storage devices in the system provided therein (Hager's figs. 1, 2 and 4), would incorporate the use of webbased system having a central storage location, in the same conventional manner as described by Balijepalli (figs. 1, 2 & 8 and section 0063-0064). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claim 23, Hager teaches forming an invention disclosure online by entering a plurality of selected information into a web-based system (an invention disclosure document is displayed as shown in fig. 4A in order to a user/inventor to create an invention disclosure document on-line via the network of LAN (fig. 1, Local Area Network (LAN) and col. 3, lines 40-67 and col. 4, lines 1-15) by entering inventors' information, title of invention: col. 3, lines 30-52 and col. 6, lines 41-67);

after each of the plurality of selected information is entered (the entered information or information portions of invention disclosure documented is storage in the storage device: fig. 1, item 14 col. 3, lines 16-30);

allowing access to various users to access the information (the user/staff, inventor or co-inventor, who are enabled to get into the system to review the invention disclosure document: fig. 2, col. 30-45);

prompting the user for classification information; notifying an evaluator in response to the classification information and prompting an evaluator from the evaluator (inventor's name, location: fig. 4 and col. 6, lines 41-67; functional code: col. 7, lines 1-8 and evaluation; col. 5, lines 1-12 and lines 22-38).

Hager teaches a creating an invention disclosure document by entering the information of invention into a form displayed as shown in fig. 4 via computer network such as LAN or Internet network (col. 3, lines 40-67) and the entered information or invention disclosure document is enabled for a user to review it. Also Hager teaches LAN coupled via communications link to gateway server (col. 3, lines 35-67) and a central computer system may coupled to a storage device which may serve as remote storage for LAN (col. 3, lines 30-35). Hager does not clearly teach a web server, a web browser, web login.

However, Balijepalli teaches central server is coupled with database (figs. 1, 2 & 8, over the Internet network/web server: abstract, sections 0008-0010, 0030 and 0063-0064) and login web ser screen (figs. 5 and 6, sections 0026).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager with the teachings of Balijepalli, wherein the online creation of invention disclosure document to be entered via a computer network coupling to LAN communication links and storage devices in the system provided therein (Hager's figs. 1, 2 and 4), would incorporate the use of webbased system having a central storage location, in the same conventional manner as described by Balijepalli (figs. 1, 2 & 8 and section 0063-0064). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claim 24, Hager teaches a method as discussed in claim 23.

Hager teaches a creating an invention disclosure document by entering the information of invention into a form displayed as shown in fig. 4 via computer network such as LAN or Internet network (col. 3, lines 40-67) and the entered information or invention disclosure document is enabled for a user to review it. Also Hager teaches LAN coupled via communications link to gateway server (col. 3, lines 35-67) and a central computer system may coupled to a storage device which may serve as remote storage for LAN (col. 3, lines 30-35). Hager does not clearly teach a web server.

However, Balijepalli teaches central server is coupled with database (figs. 1, 2 & 8, over the Internet network/web server: abstract, sections 0008-0010, 0030 and 0063-0064) and login web ser screen (figs. 5 and 6, sections 0026).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager with the teachings of Balijepalli, wherein the online creation of invention disclosure document to be entered via a computer network coupling to LAN communication links and storage devices in the system provided therein (Hager's figs. 1, 2 and 4), would incorporate the use of webbased system having a central storage location, in the same conventional manner as described by Balijepalli (figs. 1, 2 & 8 and section 0063-0064). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claim 37, Hager teaches entering identification information (fig. 4a, col. 6, lines 41-67);

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retrieving user information from a directory system in response to said (retrieving document: fig. 4, col. 6, lines 15-22);

identification information entering disclosure information to create an invention disclosure (fig. 2, col. 16-65 and col. 6, lines 41-67);

coupling said user information with said disclosure (fig. 4, col. 6, lines 41-67) and storing the disclosures in the database (col. 3, lines 5-30, fig. 1, item 14).

Hager teaches a creating an invention disclosure document by entering the information of invention into a form displayed as shown in fig. 4 via computer network such as LAN or Internet network (col. 3, lines 40-67) and the entered information or invention disclosure document is enabled for a user to review it. Also Hager teaches LAN coupled via communications link to gateway server (col. 3, lines 35-67) and a central computer system may coupled to a storage device which may serve as remote storage for LAN (col. 3, lines 30-35). Hager does not clearly teach a central storage location and web-based system.

However, Balijepalli teaches central server is coupled with database (figs. 1, 2 & 8, over the Internet network/web server: abstract, sections 0008-0010, 0030 and 0063-0064).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager with the teachings of Balijepalli, wherein the online creation of invention disclosure document to be entered via a computer network coupling to LAN communication links and storage devices in the system provided therein (Hager's figs. 1, 2 and 4), would incorporate the use of web-

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based system having a central storage location, in the same conventional manner as described by Balijepalli (figs. 1, 2 & 8 and section 0063-0064). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claim 38 and 41, Hager teaches prompting the user for classification information (functional code: col. 7, lines 1-8); and

prompting a patentability review from the patent staff person (the user/staff, inventor or co-inventor, who are enabled to get into the system to review the invention disclosure document: fig. 2, col. 30-45).

9. Claims 4-6, 8, 10-15, 25-35, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager) in view of Pub. No.: US 2004/0230566 A1 of Balijepalli et al. (hereinafter (Balijepalli). and further in view of US Patent No. 5,987,464 issued to Schneider.

With respect to claims 4-6 and 8, Hager in view of Balijepalli discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach generating an E-mail; providing a hyperlink to the disclosure in the E-mail; notifying a patent staff person in response to the

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classification information; prompting an evaluation comprises scheduling an evaluation meeting.

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Schneider by incorporating the use of email, hyperlink and scheduling for meeting. The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claims 10-15, Hager in view of Balijepalli discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; providing a status update via E-mail.

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8 and see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Schneider by incorporating the use of email, hyperlink and scheduling for meeting. The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claims 25-29, Hager in view of Balijepalli discloses a system as discussed in claim 23.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach notifying comprises the step of generating an E-mail having a hyperlink therein; providing a status update via E-mail, scheduling an evaluation meeting, ranking the disclosure, and notifying a patent staff person.

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8 and see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Schneider by incorporating the use of email, hyperlink and scheduling for meeting. The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

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With respect to claims 30-35, Hager in view of Balijepalli discloses a system as discussed in claim 23.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; viewing the status of the invention disclosure on-line; providing a status update via E-mail.

However, Schneider discloses database connecting with web server, notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Schneider by incorporating the use of email, hyperlink and scheduling for meeting. The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claims 39-40, Hager in view of Balijepalli discloses a method as discussed in claim 37.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; and notifying a patent staff person in response to the classification information.

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However, Schneider discloses notifying an evaluator and notifying to a patent staff as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Schneider by incorporating the use of email, hyperlink and scheduling for meeting. The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

10. Claims 16 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager) in view of Pub. No.: US 2004/0230566 A1 of Balijepalli et al. (hereinafter (Balijepalli). and further in view of Pub. No.: US 2003/0046307 A1 of Rivette et al. (hereinafter Rivette).

With respect to claim 16, Hager in view of Balijepalli discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach scanning said paper submission into the database.

However, Rivette teaches paper patents with images on it or image papers, that are to be scanned and displayed to user, are preferably HTML data rendered by the browser (sections 0011, 0256 and 1246).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Rivette, wherein the data or IP is stored in the memory portion of the data sever in the system provided therein (see fig 9), would incorporate the use of memory or storage of web or data server site over the network to stored the information or data, in the same conventional manner as described by Rivette (sections 0486-0489). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

With respect to claim 36, Hager in view of Balijepalli discloses a method of forming an on-line invention disclosure as discussed in claim 23.

Hager and Balijepalli disclose substantially the invention as claimed.

Hager and Balijepalli do not teach scanning said paper submission into the database.

However, Rivette teaches paper patents with images on it or image papers, that are to be scanned and displayed to user, are preferably HTML data rendered by the browser (sections 0011, 0256 and 1246).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hager in view of Balijepalli with the teachings of Rivette, wherein the data or IP is stored in the memory portion of

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the data sever in the system provided therein (see fig 9), would incorporate the use of memory or storage of web or data server site over the network to stored the information or data, in the same conventional manner as described by Rivette (sections 0486-0489). The motivation being to be easily and effectively to retrieve, update, display the information or data from the Internet network to the web client.

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Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV or fax to (571) 273-4039. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or Primary Examiner Jean Corrielus (571) 272-4032.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: Central Fax Center (571) 273-8300

ANH LY 19th, 2005

JEAN M. CORRIELUS